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APPLICATION NO. FILING DATE FIRST NAMED INVENTOR CONFIRMATION NO. ATTORNEY DOCKET NO. 10/696,284 10/29/2003 Ahmad Akashe 77017 6489 22242 7590 10/01/2004 EXAMINER FITCH EVEN TABIN AND FLANNERY WEIER, ANTHONY J 120 SOUTH LA SALLE STREET **SUITE 1600** ART UNIT PAPER NUMBER CHICAGO, IL 60603-3406 1761

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summan	10/696,284	AKASHE ET AL.
Office Action Summary	Examiner	Art Unit
The BAAU INC. DO THE CO.	Anthony Weier	1761
The MAILING DATE of this communication app Period for Reply	pears on the cover sheet w	ith the correspondence address
A SHORTENED STATUTORY PERIOD FOR REPL' THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply - If NO period for reply is specified above, the maximum statutory period v - Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	36(a). In no event, however, may a sy within the statutory minimum of thir vill apply and will expire SIX (6) MON	ty (30) days will be considered timely.  ITHS from the mailing date of this communication.
Status		
1)⊠ Responsive to communication(s) filed on <u>07 Secondary</u>	entember 2004	
2a) ☐ This action is <b>FINAL</b> . 2b) ☒ This action is non-final.		
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is		
closed in accordance with the practice under E	x parte Quayle, 1935 C.D	. 11, 453 O.G. 213.
Disposition of Claims		
4)⊠ Claim(s) <u>1-20</u> is/are pending in the application.		
4a) Of the above claim(s) <u>1-10</u> is/are withdrawn from consideration.		
5) Claim(s) is/are allowed.		
6)⊠ Claim(s) <u>11-20</u> is/are rejected.		
7) Claim(s) is/are objected to.		
8) Claim(s) are subject to restriction and/or	election requirement.	
Application Papers		
9)☐ The specification is objected to by the Examiner	<u>.</u>	
10) The drawing(s) filed on is/are: a) acce		ov the Examiner
Applicant may not request that any objection to the d	rawing(s) be held in abeyan	ce. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction	on is required if the drawing(	s) is objected to. See 37 CFR 1 121(d)
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.		
Priority under 35 U.S.C. § 119		
12) Acknowledgment is made of a claim for foreign	oriority under 35 U.S.C. &	119(a)-(d) or (f)
a) ☐ All b) ☐ Some * c) ☐ None of:		
1. Certified copies of the priority documents have been received.		
2. Certified copies of the priority documents have been received in Application No		
3. Copies of the certified copies of the priority documents have been received in this National Stage		
application from the International Bureau (PCT Rule 17.2(a)).		
* See the attached detailed Office action for a list o	f the certified copies not re	eceived.
Attachment(s)		
1) Notice of References Cited (PTO-892)	4) 🔲 Interview Su	mmary (PTO-413)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	Paper No(s)/	Mail Date
Paper No(s)/Mail Date	5)  Notice of Info 6)  Other:	ormal Patent Application (PTO-152)
J.S. Patent and Trademark Office PTOL-326 (Rev. 1-04) Office Action	on Summary	Part of Paper No /Mail Date 092704

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#### **DETAILED ACTION**

#### Election/Restrictions

1. Applicant's election without traverse of Group II in the reply filed on 9/7/04 is acknowledged.

### **Double Patenting**

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 11-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-28 of copending Application No. 10/655478. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims call for the preparation of a fermented soy-containing product wherein the deflavored soy protein material is fermented. The claims of 10/655478 refer to the preparation of beverages including smoothies. These claims do not call for a fermenting step in preparation of the beverage, but they also do not exclude same. Smoothies and other similar products such as shakes are known to include yogurt ingredients. As such, it would have been

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obvious to one having ordinary skill in the art at the time of the invention to have modified the invention of the claims of 10/655478 to include the fermentation and inclusion of yogurt as an art recognized ingredient in at least thick beverages such as smoothies or shakes.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 11-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 10/655259. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims call for steps of creating a fermented soy product. Although the claims of 10/655259 stop short of same and are primarily directed to creation of the soy protein component, it is well known to ferment soybean protein to form yogurt. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have added the steps of creating yogurt through fermentation as an art recognized use of soy protein and as a matter of preference.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 11-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 10-28 of U.S. Patent No. 6787173. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of U.S. Patent No. 6787173 further include

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steps directed to recycling and further recovery of elements and the instant claims call for the preparation of a fermented soy product. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to have removed the recycling and recovery steps to provide for an, albeit, less efficient, process. In addition, In addition, it is well known to use soy protein in creating a fermented soy product (e.g. yogurt), and it would have been further obvious to have fermented the soy protein of U.S. Patent No. 6787173 to effect a soy yogurt product as an art recognized alternative use for soy protein.

# Claim Rejections - 35 USC § 103

- 5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 6. Claims 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodnight, Jr. et al (U.S. Patent No. 4091,120) taken together with Cole et al.

Goodnight, Jr. et al discloses preparation of a soybean slurry from soy flour wherein the concentration of soybean is as called for in the claims and wherein the pH of the slurry is adjusted as set forth in the instant claims and the resulting slurry is passed through an ultrafiltration membrane, inherently polymeric, having a cutoff and employing the processing temperature as claimed. The soy protein created therein is inherently deflavored taking into account the similarity in processing between the instant invention and that of Goodnight, Jr. et al (see cols. 2-4; examples).

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The claims differ in that the soy protein is then fermented to create a yogurt product. However, it is well known to include soy protein in the preparation of yogurt as taught, for example, by Cole et al. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included soybean protein of Goodnight, Jr. et al in yogurt as a well known alternative use of soy protein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 571-272-1409. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony Weier Primary Examiner

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Anthony Weier September 27, 2004